

REMARKS

Claims in the case are 1 and 3. Claims 2 and 4-6 have been cancelled without prejudice herein. No claims have been amended, and no claims have been added herein.

The specification stands objected to with regard to section headings. This objection is respectfully traversed in light of the amendments herein and the following remarks.

The specification has been amended herein to include appropriate section headings. In light of the amendments herein, the objection to the specification is deemed to have been fully addressed. Reconsideration and withdrawal of the present objection is respectfully requested.

Claims 2 and 4-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,300,575 (**Jonas et al**). Claims 2 and 4-6 have been cancelled without prejudice herein. As such, this rejection is deemed to be presently moot.

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jonas et al in view of United States Patent No. 4,728,399 (**Moehwald**). This rejection is respectfully traversed in light of the following remarks.

Jonas et al discloses first forming a polythiophene polymer in a dispersion, and then applying the dispersion to a substrate. Jonas et al does not disclose, teach or suggest forming a polythiophene polymer *in situ* by polymerizing thiophene monomers on the surface of the substrate. Jonas et al disclose applying their polythiophene dispersions to substrates including, molded organic plastics, glass and ceramics (column 5, lines 14-23). Jonas et al do not disclose, teach or suggest applying their polythiophene dispersions to metal substrates.

Moehwald discloses forming a conductive polymer *in situ* by polymerizing monomers on the surface of a metal substrate. Moehwald does not disclose, teach or suggest first forming a conductive polymer (e.g., in an aqueous solution), and then applying the preformed conductive polymer to a substrate. Moehwald teaches away from first forming a conductive polymer, and then applying the preformed conductive polymer to a substrate. Moehwald disclose that their process provides for: improved adhesion to the metal substrate; and dispensing with the need to pre-

treat the surface of the metal substrate. See column 1, lines 39-45, and column 1, lines 58-61 of Moehwald.


In light of the preceding remarks, neither Jonas et al nor Moehwald provide the requisite disclosure that would motivate a skilled artisan to combine or otherwise modify their respective disclosures to arrive at Applicants' claimed method. As the Court of Appeals for the Federal Circuit has stated, there are three possible sources for motivation to combine references in a manner that would render claims obvious. These are: (1) the nature of the problem to be solved; (2) the teaching of the prior art; and (3) the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The nature of the problem to be solved and the knowledge of persons of ordinary skill in the art are not present here and have not been relied upon in the rejection. As for the teaching of the prior art, the above discussion has established that neither of the patents relied upon in the rejection provide the requisite teaching, and certainly do not provide the motivation or suggestion to combine that is required by Court decisions.

It is respectfully submitted that the rejection impermissibly uses Applicants' application as a blueprint for selecting and combining or modifying the cited references to arrive at Applicants' claimed invention, thereby making use of prohibited hindsight in the selection and application of the cited references. The use of hindsight reconstruction of an invention is an illogical and inappropriate process by which to determine patentability. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Modifying "prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

In light of the preceding remarks, Applicants' claims are deemed to be unobvious and patentable over Jonas et al in view of Moehwald. Reconsideration and withdrawal of the present rejection is respectfully requested.

In light of the amendments herein and the preceding remarks, Applicants' presently pending claims are deemed to define an invention that is unanticipated, unobvious and hence, patentable. Reconsideration of the rejections and allowance of all of the presently pending claims is respectfully requested.

Respectfully submitted,

By 
James R. Franks
Agent for Applicants
Reg. No. 42,552

Bayer MaterialScience LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3808
FACSIMILE PHONE NUMBER:
(412) 777-3902